

### **REMARKS**

Claims 119-153, 168-194, and 230-312 are now pending in this application. Claims 1-118, 154-167, and 195-229 have been canceled. Claims 119-134, 137-141, 143-151, 168-186, 188-194, and 230 have been amended herein and claims 231-312 have been added. In the non-final Office Action dated November 1, 2005, the Office made final the Restriction Requirement dated September 20, 2005, despite Applicants' traversal dated October 2, 2005, and presented several rejections of claims 119-153, 168-194, and 230. Applicants now present the following remarks and arguments concerning the patentability of claims 119-153, 168-194, and 230-312.

#### **Claim Amendments and New Claims**

Applicants have amended independent claims 119 and 168 by adding the recitation "wherein said nascent tissue web has a basis weight of less than about 35 pounds/ream," which is fully supported in the original specification by at least paragraph [0129]. Applicants have further amended independent claims 119 and 168 by adding the recitation "a formation index of greater than about 42," which is fully supported in the original specification by at least Figure 6. Applicants have also amended independent claim 168 by adding the recitation "wherein said nascent tissue web is formed at a line speed in excess of 1000 feet/minute," which is fully supported in the original specification by at least paragraph [0106].

Applicants have amended dependent claims 120-134, 137-141, 143-151, 169-186, 188-194, and 230 to conform those claims to the amendments made to their independent claims 119 and 168, and also for the purpose of increased clarity.

Applicants have added new independent claims 233 and 273 that recite, *inter alia*, “wherein said nascent tissue web has a CD wet breaking length of at least about 250 meters,” which is fully supported in the original specification by at least paragraph [005]. Newly added independent claims 233 and 273 further recite, *inter alia*, “a SAT capacity of at least about 5 grams/gram,” which is fully supported in the original specification by at least paragraph [005].

Applicants have added new dependent claims 231, 232, 268, and 308 that recite, *inter alia*, “wherein said nascent tissue web is formed by use of a slotted screen,” which is fully supported in the original specification by at least paragraph [0133]. Applicants have further added new dependent claims 234-267, 269-272, 274-307, and 309-312, which Applicants believe are fully supported by the original specification and, in general, by original claims 120-163.

Applicants believe that amended claims 119, 122-134, 137-141, 143-151, 168, 171-186, 188-194, and 230, and newly added claims 231-312, add no new matter and are fully supported by the original specification. Applicants further submit that the skilled artisan would understand Applicants to have been in possession of the claimed subject matter at the time this application was filed. In addition, each of the newly added claims 231-312 are within the scope of Applicants’ prior election of Group II, drawn to methods, and are commensurate with the Office’s Restriction Requirement dated September 20, 2005. Therefore, Applicants request that the Office enter the new and amended claims without objection. Applicants invite Examiner to contact the undersigned representative if there is any question regarding the support for, or the language of, any of the amendments to those claims.

**Rejection Under 35 U.S.C. § 112**

The Office rejected claims 123 and 172 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. In particular, the Office states that there is insufficient antecedent basis for the limitation “wet-strength resin” in those claims, since claims 122 and 171 recite a “wet strength adjusting agent.” See Office Action at page 3. Applicants have amended herein each of claims 122, 123, 171, and 172 to recite a “wet strength agent,” as used in at least paragraph [0080] of the original specification. Applicants believe that this amendment clarifies the antecedent basis and is fully supported by the original specification. Therefore, Applicants respectfully request that this rejection be withdrawn.

**Rejection Under 35 U.S.C. § 102(b)**

The Office rejected claims 168-169, 171-177, 179-180, 183-186, 188-194, and 230 under 35 U.S.C. § 102(b) as anticipated by EP 0 810 078 to Schmidt et al. (“EP ‘078”). See Office Action at page 3. Applicants respectfully traverse this rejection.

In order to show anticipation, the Office must provide a single reference that discloses, either expressly or inherently, each and every element of the pending claims. See MPEP § 2131. Each of the rejected claims, as amended, recites that the “nascent tissue web is formed at a line speed in excess of 1000 feet/minute,” which the Office has admitted that EP ‘078 does not disclose. See Office Action at page 5. Similarly, new independent claims 233 and 273 also include that recitation. Because EP ‘078 does not teach or suggest at least “a line speed in excess of 1000 feet/minute,” the

reference does not disclose each and every element of the pending claims and, therefore, cannot properly support a rejection under 35 U.S.C. § 102(b). Applicants respectfully request that the Office withdraw this rejection of the pending claims.

**Rejections Under 35 U.S.C. § 103(a)**

The Office rejected claims 119-120, 122-128, 130-131, 134-141, 143-153, and 182 under 35 U.S.C. § 103(a) as obvious over EP '078 in view of U.S. Patent No. 5,254,399 to Oku et al ("the '399 patent"). In particular, the Office states that the '399 patent teaches that a wet-laid former can run at a line speed of 500 meters/minute or more. Thus, the Office believes that it would have been obvious to a person of ordinary skill in the art to have formed a web using the process of EP '078 at a speed of at least 1000 feet/minute, in view of the '399 patent, in an effort to maximize the output of the process. See Office Action at 5-6. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must have been a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The references cited in the Office Action fail to meet any of these requirements.

In making a comparison for the purposes of 35 U.S.C. § 103(a), the question is not whether the differences themselves between the prior art and the claims would have been obvious, but whether the claimed invention as a whole would have been obvious.

See MPEP § 2141.02. As an initial matter, EP '078 and the subject matter of the instant claims are directed to different products that are intended for different purposes. EP '078 is directed to a method for providing a fluffy, high basis weight absorbent fluid distribution material, whereas the instant claims are directed to a low basis weight tissue product with a high formation index. Taken as a whole, the skilled artisan would not have been provided with any suggestion or motivation to combine or modify the fluffy, low basis weight absorbent fluid distribution material of EP '078 in an effort to achieve the tissue product of the instant claims; therefore, regardless of what the '399 patent may disclose, Applicants submit that EP '078 cannot properly form the basis for a *prima facie* case of obviousness of the noted claims.

Basis Weight. As noted above, EP '078 is not directed to the formation of a nascent tissue web, as is each of the pending claims, but rather is directed to the formation of an absorbent wicking core structure for use in articles like baby diapers, incontinence products, and catamenial products. See page 2, lines 5-8. The reference is particularly directed to improving the wicking capabilities of those core structures through a "key" mechanical treatment process that results in permanent deformation of the web. See page 7, lines 29-37. The skilled artisan is readily aware that, among the many differences between wicking cores and tissue webs, wicking cores generally have a heavier basis weight than tissue webs. In fact, the examples on page 10 of EP '078 disclose absorbent wicking core webs having a basis weight of  $150 \text{ g/m}^2$ , which is equivalent to 92 pounds/ream. That basis weight is almost three times greater than the basis weight of less than about 35 pounds/ream, which is recited in each of the independent claims. Applicants believe that the difference in basis weight alone reveals

that the skilled artisan would not have been motivated to modify the heavy wicking cores of EP '078 in order to achieve the tissue webs of the present claims. Quite simply, the particular machine characteristics and settings used to create those heavy, fluffy cores are generally not applicable to a lower basis weight, more compact tissue web. The '399 patent does not provide any additional information or motivation to make such a modification. Therefore, the skilled artisan would have had no motivation or suggestion to modify EP '078, or to combine it with any other reference of record, in order to achieve the presently claimed inventions.

Formation Index. Independent claims 119, 168, and 273 recite, *inter alia*, a “formation index of greater than about 42.” The specification notes that formation refers to the “uniformity with which fibers form a sheet.” Paragraph [0132]. The skilled artisan is aware that, as the basis weight of a paper product increases, the quality of formation of that paper product generally becomes less important. The increased weight of the web helps mask out many of the problems caused by poor formation in lighter webs. As noted above, the product of EP '078 is a relatively heavy product as compared to the recited basis weights of the claimed inventions and, as such, would not possess or require a formation index of greater than about 42. Not only does EP '078 not teach or disclose formation index at all, let alone the recited formation index of greater than about 42, but it does not even discuss or allude to the importance of good formation. That lack of disclosure underscores the skilled artisan's inability to modify the reference, or combine it with any other reference of record, in order to achieve a web with a basis weight of less than about 35 pounds/ream and a formation index of greater than about 42. Furthermore, the skilled artisan would not have had any reasonable expectation of

success in modifying EP '078 to achieve a web with a basis weight of less than about 35 pounds/ream and a formation index of greater than about 42.

In fact, neither EP '078 nor the '399 patent, taken either alone or in combination, teach or suggest a method of making a tissue web having a formation index of greater than about 42. Therefore, those references would not have provided one of ordinary skill in the art with any suggestion or motivation to combine or modify their teachings in an effort to achieve all of the limitations of the instant invention and, as such, cannot properly form the basis for a *prima facie* case of obviousness.

Line Speed. Despite the Office's assertion, Applicants submit that one of ordinary skill in the art would not have been motivated to combine EP '078 with the '399 patent to achieve the claimed inventions with a line speed of over 1000 feet/minute. Regardless of what the '399 patent may teach regarding line speed, the skilled artisan readily knows that the wicking cores of EP '078 could not be formed at a line speed of over 1000 feet/minute due to their high basis weight. In addition, the skilled artisan knows that, in general, increased line speeds may lead to poorer formation and, hence, a lower formation index. Because EP '078 is directed to a higher basis weight paper product, and because the reference does not teach or disclose anything about formation or a formation index of greater than about 42, one of ordinary skill in the art would not have been motivated to combine the process of EP '078 with the line speed of the '399 patent, at least not with any reasonable expectation of achieving a tissue web product with a formation index greater than about 42.

CD Wet Breaking Length. Newly added independent claims 233 and 273 each recite that the tissue web has, *inter alia*, "a CD wet breaking length of at least about 250

meters.” Neither EP ‘078 nor the ‘399 patent teach or suggest a tissue web having a CD wet breaking length of at least about 250 meters. In fact, the skilled artisan would readily know that, in general, a fluffy, high basis weight absorbent wicking core of the type disclosed in EP ‘078 would not possess a CD web breaking length of at least about 250 meters. While a CD wet breaking length of the claimed amount is desirable in consumer paper products, such a property would neither be an important nor a desired feature in the wicking cores of EP ‘078. In fact, the disclosure of EP ‘078 itself states that the absorbent cores would not be used by themselves, but instead in combination with other structures that may provide any desired breaking properties, such as a topsheet, a backsheet, or a “a fluid pervious sheet . . . to increase integrity of the fluid member during processing and/or use.” Page 13, lines 24-57. Therefore, the skilled artisan would not have been motivated to modify the absorbent cores of EP ‘078 to achieve the claimed tissue webs with a CD wet breaking length of at least about 250 meters. No reference of record remedies that deficiency and, therefore, a *prima facie* case of obviousness cannot be made for the noted claims and their dependencies.

SAT Capacity. Newly added independent claims 233 and 237 each recite, *inter alia*, that the tissue web has “a SAT capacity of at least about 5 grams/gram.” Neither EP ‘078 nor the ‘399 patent teach or suggest a tissue web having a SAT capacity of at least about 5 grams/gram. Because neither EP ‘078 nor the ‘399 patent teaches or suggests a method for making a paper product wherein the tissue web has a “SAT capacity of at least about 5 grams/gram,” those references would not have provided one of ordinary skill in the art with any suggestion or motivation to combine or modify their teachings in an effort to achieve all of the limitations of the claimed invention. Because



the references cannot properly form the basis of a proper *prima facie* case of obviousness, Applicants respectfully request that the Office withdraw this rejection.

Remaining References. Finally, the Office uses certain references other than EP '078 and the '399 patent to show support for the subject matter of various dependent claims. The Office rejected claims 121, 129, 133, 170, 178, and 182 under 35 U.S.C. § 103(a) as obvious over EP '078 in view of the '399 patent and further in view of WO 96/12615 to Anderson et al. ("WO '615"). The Office states that WO '615 discloses a method of making a wet-laid bonded fibrous web containing bi-component fibers and cellulosic fibers, and that the papermaking and bi-component fibers can be added separately to make a stratified web with a central layer having mostly bi-component fibers and outer layers having mostly cellulosic fibers. See Office Action at 6. The Office has also rejected claims 132 and 181 under 35 U.S.C. § 103(a) as obvious over EP '078 in view of the '399 patent and further in view of 6,162,327 to Batra et al. ("the '327 patent"). The Office states that the '327 patent discloses that the tissue can be creped, uncreped, or microcreped. See Office Action at 7. The Office further has rejected claims 142 and 187 under 35 U.S.C. § 103(a) as being unpatentable over EP '078 in view of the '399 patent and further in view of EP 0 465 203 to Nielson et al. ("EP '203"). The Office states that EP '203 discloses that a nonionic dispersing agent can be added to modify the surface of the fibers for hydrophilicity. See Office Action at 7.

Regardless of what the additional references may teach or disclose, they do not remedy the previously mentioned deficiencies in EP '078 and the '399 patent. Like EP '078 and the '399 patent, neither WO '615, the '327 patent, nor EP '203 teaches or discloses at least a nascent tissue web having a "formation index of greater than about

42,” “a line speed of over 1000 ft/min,” “a CD wet breaking length of at least about 250 meters,” or “a SAT capacity of at least about 5 grams/gram.” Therefore, those additional references cannot further support a *prima facie* case of obviousness.

Because none of the references cited, either taken alone or in any combination, teaches or suggests the claimed inventions, they cannot properly form the basis for a *prima facie* rejection for obviousness of either any of the pending claims in this application. The skilled artisan simply would not have been motivated to modify or combine the various teachings of the cited references to achieve the claimed inventions, at least not with any reasonable expectation of success. Therefore, Applicants respectfully request that the Office withdraw its §103(a) rejections of the pending claims.

### **Conclusion**

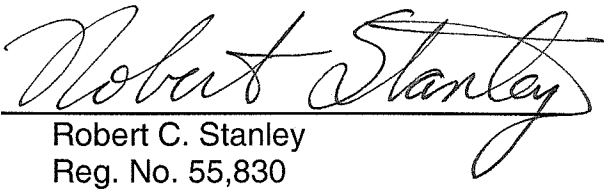
Applicants have responded to each of the rejections made by the Office in the Office Action dated November 1, 2005, and have shown that the pending claims, as amended herein, are neither anticipated nor rendered obvious by any of the references of record. Therefore, Applicants respectfully request that the Office pass to allowance claims 119-153, 168-194, and 230-312. If the Office has any questions regarding this application, or would like to discuss this paper in greater detail, Applicants invite the Office to contact the undersigned representative at the information listed below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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